

### ***Rejections under 35 U.S.C. § 101***

Claim 41 is rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 5 of prior U.S. Patent no. 5,321,913. Applicants respectfully disagree, and suggest that a double-patenting rejection is not appropriate.

In determining whether a statutory basis for a double patenting rejection exists, the relevant question is whether the same invention is being claimed twice. In the context of 35 U.S.C. § 101, "same invention" means identical subject matter (see MPEP § 804(II)(A)). Applicant suggests that the subject matter of instant claim 41 is not identical with the subject matter of claim 5 of U.S. 5,321,913.

For example, Applicant notes that claim 5 of U.S. 5,321,913 depends from claim 1 of that patent, and therefore recites a sander comprising a platen, a fastener associated with the platen, an abrasive sheet fastened to the platen by the fastener, a first drive mechanism interconnecting the platen and the frame and configured to move the platen in a first motion, and a second drive mechanism interconnecting the platen and the frame and configured to move the platen in a second motion.

In contrast, instant claim 41 recites an "abrasive sheet structure", and a drive mechanism interconnecting the frame and the abrasive sheet structure. Applicant suggests that although overlap may exist in the scopes of claim 5 and claim 41, it is clear that the scopes of the two claims is not identical, as required for a proper statutory double-patenting rejection. Applicant respectfully suggests that the two claims do not claim identical subject matter.

Applicant further notes that a reliable test for double patenting under 35 U.S.C.

101 is whether a claim in the pending application could be literally infringed without literally infringing the asserted claim in the issued patent (see *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)). In the present case, one could imagine a sander comprising a frame, an abrasive sheet structure, a drive mechanism and a conveyor as recited in instant claim 41, that would nonetheless fail to literally infringe claim 5 of U.S. 5,321,913.

For at least these reasons, Applicant respectfully suggests that a statutory double-patenting rejection of claim 41 over claim 5 of the U.S. 5,321,913 patent is improper, and requests the withdrawal of the rejection under 35 U.S.C. § 101.

Applicant also suggests that a non-statutory obviousness-type double-patenting rejection would be similarly inappropriate. However, in the interest of facilitating the prosecution of the application, Applicant hereby submits a terminal disclaimer of the instant application over U.S. Patent no. 5,321,913 to obviate such a potential obviousness-type double-patenting rejection.

In view of the above remarks, and the submission of the terminal disclaimer, Applicant respectfully requests the withdrawal of the rejection of claim 41 under 35 U.S.C. § 101, and the allowance of the application.

### ***Allowed Subject Matter***

Applicant gratefully acknowledges the allowance of claims 17, 26, 34, and 36-37.

With the consideration of the above remarks, and the entry of the enclosed terminal disclaimer, Applicant submits that all of the issues raised in the Office action have been addressed and overcome. If the Examiner has any questions or if there are any remaining issues, Applicant's undersigned agent may be reached at the number listed below.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on January 26, 2005.



Suzanne Lukas-Werner

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Anton E. Skaugset

Registration No. 38,617

Customer PTO No. 23581

of Attorneys/Agents for Applicant

200 Pacific Building

520 S.W. Yamhill Street

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679